

REMARKS

Rejection Under 35 U.S.C. §103(a)

The Examiner maintained the rejection of claims 1, 3, 5, and 6 under 35 U.S.C. §103(a) as allegedly being unpatentable over JP06270329 (herein referred to as Yuka '329), JP07195870 (herein referred to as Yuka '870), JP08121092 (herein referred to as Yuka '192), or JP05204609 (herein referred to as Yuka '609) in view of Taylor (US 4,292,105).

In addition, the Examiner maintained the rejection of claims 1, 3, 5, and 6 under 35 U.S.C. §103(a) as allegedly being unpatentable over JP06270329 (herein referred to as Yuka '329), JP07195870 (herein referred to as Yuka '870), JP08121092 (herein referred to as Yuka '192), or JP05204609 (herein referred to as Yuka '609), in view of Benzinger (US 3,617,613).

The Examiner also maintained the rejection of claims 1, 3, 5, and 6 under 35 U.S.C. §103(a) as allegedly being unpatentable over JP06270329 (herein referred to as Yuka '329), JP07195870 (herein referred to as Yuka '870), JP08121092 (herein referred to as Yuka '192), or JP05204609 (herein referred to as Yuka '609), in view of Casadevall (US 3,960,626).

Further, the Examiner maintained the rejection of claims 6-8 under 35 U.S.C. §103(a) as allegedly being unpatentable over Franz et al. (US 3,922,459) in view of JP06270329 (herein referred to as Yuka '329), JP07195870 (herein referred to as Yuka '870), JP08121092 (herein referred to as Yuka '192), or JP05204609 (herein referred to as Yuka '609).

Finally, the Examiner maintained the rejection of claims 1, 3 and 5-8 under 35 U.S.C. §103(a) as allegedly being unpatentable over Burke (US 3,619,342) in view of JP06270329 (herein referred to as Yuka '329), JP07195870 (herein referred to as Yuka '870), JP08121092 (herein referred to as Yuka '192), or JP05204609 (herein referred to as Yuka '609).

In response to the Examiner's rejections, applicants respectfully traverse, and maintain that the Examiner has failed to establish a *prima facie* case of obviousness against the rejected claims.

Briefly, claims 1, 3, 5 and 6 provide a material to be molded comprising a porous material impregnated with a phenolic resin wherein the phenolic resin is both at least partially sulfomethylated and/or sulfimethylated and at B-stage of polymer condensation. Surprisingly, this combination gives the claimed material increased moldability, storage life and heat resistance, as compared to phenolic resins that are *either* sulfomethylated *or* at B-stage of polymer condensation, but not both. Claims 7 and 8 provide an interior material comprising a base formed of the material of claim 1.

To establish a *prima facie* case of obviousness, the Examiner must demonstrate three things with respect to each claim. First, the cited references, when combined, teach or suggest each element of the claim. Second, one of ordinary skill would have been motivated to combine the teachings of the cited references at the time of the invention. And third, there would have been a reasonable expectation that the claimed invention would succeed.

Applicants maintain that the references cited against the rejected claims fail to support a *prima facie* case of obviousness for the reasons set forth in their August 8, 2002 Amendment and the additional reasons set forth below.

Specifically, to support a case of *prima facie* obviousness, Yuka '329, '870, '192 or '609 ("sulfomethylated resin" references), in view of any of Taylor, Benzinger, Casadevall, Franz or Burke ("non-sulfomethylated resin" references), when combined, would have to teach or suggest all elements of the rejected claims. Moreover, there would have to have been a motive to combine them, and a reasonable expectation of the invention's success at the time of the invention.

Again, one element of each rejected claim is a phenolic resin that is both at least partially sulfomethylated and/or sulfimethylated and at B-stage of polymer condensation. Thus, at the very least, these references would have to teach or suggest this element.

This they fail to do. Applicants discovered that when a phenolic resin that is both at least partially sulfomethylated and/or sulfimethylated and at B-stage of polymer condensation is impregnated into a porous material, it gives the material increased moldability, storage life and heat resistance.

Before applicants' discovery, it would have defied known principles to conclude that a phenolic resin could impart all three characteristics on a porous material since prior to applicants' discovery, it was known that materials impregnated with thermosetting resins had a short storage life (see page 1, line 37 - page 2, line 1 of the subject specification).

It also would have been surprising to one of skill in the art that sulfomethylation of the condensation polymer would improve the polymer's stability with respect to advancing to the B-stage, i.e. the porous material stays at the B-stage without advancing to the C-stage for a long time so that good moldability and a high bonding strength is ensured for a long time as applicants previously demonstrated in the results of their "Sticking Test".

Further, applicants point out that the Yuka references do not state that sulfomethylation of the condensation polymer improves the stability of the condensation polymer which is impregnated in the porous material. Instead, the Yuka references disclose that sulfomethylation of the condensation polymer improves the stability of the water solution containing the condensation polymer, i.e. that the polymer dissolves in water without sedimenting out of solution for a long time.

Thus, Yuka '329, '870, '192 or '609, in view of any of Taylor, Benzinger, Casadevall, Franz or Burke do not teach or suggest all elements of the rejected claims. Furthermore, applicants maintain that there was no motivation to combine these references at the time of the invention. The Examiner has failed to show such motivation, or how one would have reasonably expected the invention's success. Instead, applicants contend that one of skill in the art would have adopted the teachings of any of the "sulfomethylated resin" references *or* the "non-sulfomethylated resin" references, individually, but would not have been motivated to combine the teachings of both.

Accordingly, the Examiner has failed to establish the *prima facie* obviousness of claims 1, 3 and 5-8 over these references.

In view of the above remarks, applicants maintain that claims 1, 3 and 5-8 satisfy the requirements of 35 U.S.C. §103(a).

Summary

In view of the remarks made herein, applicants maintain that the claims pending in this application are in condition for allowance. Accordingly, allowance is respectfully requested.

If a telephone interview would be of assistance in advancing prosecution of the subject application, applicants' undersigned attorneys invite the Examiner to telephone them at the number provided below.

PATENT
S.N. 09/403,338
2710/60471

No fee is deemed necessary in connection with the filing of this Communication.
However, if any fee is required, authorization is hereby given to charge the amount of such fee to
Deposit Account No. 03-3125.

Respectfully submitted,
COOPER & DUNHAM LLP

A handwritten signature in black ink, consisting of a large, stylized 'D' followed by a horizontal line.

Donald S. Dowden
Reg. No. 20,701
Alan J. Morrison
Reg. No. 37,399

DSD/AJM/MVM:mg